

REMARKS:

Claims 1-6 and 10-19 are currently pending, none of which have been amended herein.

- I. In the Office Action dated August 18, 2006, the Examiner has rejected claims 1-6, 11, 12, and 15-19 under 35 USC 103(a) as obvious over USP 6,507,824 (Yon '824) in view of USP 6,714,926 (Benson '926).

Applicants respectfully traverse this rejection, for the following reasons.

Yon '824 discloses a method and system for selecting product colors.

The Examiner has acknowledged that **Yon '824** is deficient and has acknowledged that **Yon '824** "does not specifically teach storing this product selection (use) in a customer database" (Office Action dated August 18, 2006, page 4). The Examiner has suggested that **Yon '824** "teaches that a user must manually enter the use information each time he/she uses the site, rather than this information being stored in a customer database as required by the claimed invention" (Office Action dated August 18, 2006, page 4).

The Examiner has relied on **Benson '926** in an effort to remedy the acknowledged deficiencies of **Yon '824**. However, **Benson '926**, which discloses a use of browser cookies, fails to remedy the acknowledged deficiencies of Yon '824.

Yon '824 and **Benson '926**, alone or in combination, fail to describe, teach, or suggest features set forth in independent claims 1, 12, 16, 18, and 19.

Benson '926 discloses a use of browser cookies. **Yon '824** discloses a method and system for selecting product colors. It requires a very big leap to start with the teachings of **Yon '824/Benson '926** and then end up with the features as set forth in claims 1, 12, 16, 18, and 19.

CLAIMS 1-6 and 11:

Yon '824 and **Benson '926**, alone or in combination, fail to describe, teach, or suggest the features set forth in claim 1, at lines 10-21, in combination with the other claimed features. The features set forth in claim 1, at lines 10-21, are shown herein.

a customer database which stores user information, comprising user ID for specifying users of the color-designating server, and use information including requirements relating to items to be colored predetermined in correlation with user ID, and types of resin and dye or pigment which can be used for the requirements;

wherein, when the user has been identified, the conditions-designating processing unit transmits the conditions-designating screen to the user terminal;

the conditions-designating screen displays the requirements and the types of resin and dye or pigment, which are stored in the customer database in correlation with the identified user, so that the user can designate conditions data from the requirements and the types of resin and dye or pigment displayed on the conditions-designating screen; and

the color-designating server further comprises a use data receiving unit which receives, from the user terminal, the conditions data designated by the user.

Furthermore, the Examiner did not apply the correct teaching-suggestion-motivation test for an obviousness rejection under 35 USC 103(a), regarding claims 1-6 and 10-19.

When obviousness is based on the teachings of multiple art references, the Examiner must establish some suggestion, teaching, or motivation that would have led a person of ordinary skill in the art to combine the relevant art teachings in the particular manner claimed.

The test requires that the nature of the problem to be solved be such that it would have led a person of ordinary skill in the art to combine the art teachings in the particular manner claimed. Here, **Yon '824** and **Benson '926**, alone or in combination, fail to address and/or resolve the same exact problems in the same way as the subject application regarding the combinations of all features set forth in claims 1-6 and 10-19.

The Examiner has not established some suggestion, teaching, or motivation that would have led a person of ordinary skill in the art to combine the relevant art teachings in the particular manner claimed.

It requires a very big leap to start with the teachings of **Yon '824/Benson '926** and then end up with the features as set forth in claim 1.

Accordingly, in view of the above, Applicants respectfully submit that this rejection of claim 1 should be withdrawn. It is submitted that this rejection of claims 2-6 and 11 should be withdrawn by virtue of their dependency.

CLAIMS 12 and 15:

Yon '824 and Benson '926, alone or in combination, fail to describe, teach, or suggest the features set forth in claim 12, at lines 19-30, in combination with the other claimed features. The features set forth in claim 12, at lines 19-30, are shown herein.

a customer database which stores user information, comprising user ID for specifying users of the color-designating server, and use information including requirements relating to items to be colored predetermined in correlation with user ID, and types of resin and dye or pigment which can be used for the requirements; and

wherein, when the user has been identified, the conditions-designating processing unit transmits the conditions-designating screen to the user terminal;

the conditions-designating screen displays the requirements and the types of resin and dye or pigment, which are stored in the customer database in correlation with the identified user, so that the user can designate conditions data from the requirements and the types of resin and dye or pigment displayed on the conditions-designating screen; and

the color-designating server further comprises a use data receiving unit which receives, from the user terminal, the conditions data designated by the user.

Furthermore, as discussed above, the Examiner did not apply the correct teaching-suggestion-motivation test for an obviousness rejection under 35 USC 103(a).

The Examiner has acknowledged that **Yon '824** is deficient. The Examiner has relied on **Benson '926** in an effort to remedy the acknowledged deficiencies of **Yon '824**. However, **Benson '926**, which discloses a use of browser cookies, fails to remedy the acknowledged deficiencies of **Yon '824**.

Benson '926 discloses a use of browser cookies. **Yon '824** discloses a method and system for selecting product colors. It requires a very big leap to start with the teachings of **Yon '824/Benson '926** and then end up with the features as set forth in claim 12.

Accordingly, in view of the above, Applicants respectfully submit that this rejection of claim 12 should be withdrawn. It is submitted that this rejection of claim 15 should be withdrawn by virtue of its dependency.

CLAIMS 16 and 17:

Yon '824 and **Benson '926**, alone or in combination, fail to describe, teach, or suggest the features set forth in claim 16, at lines 4-16, in combination with the other claimed features. The features set forth in claim 16, at lines 4-16, are shown herein.

specifying users of the color-designating server by accessing a customer database which stores user information, comprising user ID for specifying users of the color-designating server, and use information including requirements relating to items to be

colored, predetermined in correlation with the user ID, and types of resin and dye or pigment which can be used for the requirements;

when the user has been identified, transmitting a conditions-designating screen for designating conditions data, required for determining matchable colors, to the user terminal,

the conditions-designating screen displays the requirements and the types of resin and dye or pigment, which are stored in the customer data base in correlation with the identified user, so that the user can designate conditions data from the requirements and the types of resin and dye or pigment displayed on the conditions-designating screen; and

determining colors which can be matched under the conditions specified by the conditions data, designated in the conditions-designating screen, by consulting a matchable color database, and transmitting the result to the user terminal.

Furthermore, as discussed above, the Examiner did not apply the correct teaching-suggestion-motivation test for an obviousness rejection under 35 USC 103(a).

The Examiner has acknowledged that **Yon '824** is deficient. The Examiner has relied on **Benson '926** in an effort to remedy the acknowledged deficiencies of **Yon '824**. However, **Benson '926**, which discloses a use of browser cookies, fails to remedy the acknowledged deficiencies of **Yon '824**.

Benson '926 discloses a use of browser cookies. **Yon '824** discloses a method and system for selecting product colors. It requires a very big leap to start with the teachings of **Yon '824/Benson '926** and then end up with the features as set forth in claim 16.

Accordingly, in view of the above, Applicants respectfully submit that this rejection of claim 16 should be withdrawn. It is submitted that this rejection of claim 17 should be withdrawn by virtue of its dependency.

CLAIM 18:

Yon '824 and **Benson '926**, alone or in combination, fail to describe, teach, or suggest the features set forth in claim 18, at lines 6-26, in combination with the other claimed features. The features set forth in claim 18, at lines 6-26, are shown herein.

specifying users of the color-designating server by accessing a customer database which stores user information, comprising user ID for specifying users of the color-designating server, and use information including requirements relating to items to be colored, predetermined in correlation with the user ID, and types of resin and dye or pigment which can be used for the requirements;

when the user has been identified, transmitting by the color-designating server a conditions-designating screen for designating conditions data, required for determining matchable colors, to the user terminal,

the conditions-designating screen specifying the requirements and the types of resin and dye or pigment which are stored in the customer data base in correlation with an identified user and were obtained by consulting the customer database;

the conditions-designating screen displays the requirements and the types of resin and dye or pigment, which are stored in the customer database in correlation with the identified user, so that the user can designate conditions data from the requirements and the types of resin and dye or pigment displayed on the conditions-designating screen; and

when a color has been designated from the matchable colors, and a product in the color has been designated, the color-designating server receiving designated product data for specifying the color and the product, and order data, from the user terminal;

the color-designating server transmitting the designated product data and the order data to the receive-order system; and

the receive-order system performing receive-order processing based on the order data, which has been received.

Furthermore, as discussed above, the Examiner did not apply the correct teaching-suggestion-motivation test for an obviousness rejection under 35 USC 103(a).

The Examiner has acknowledged that **Yon '824** is deficient. The Examiner has relied on **Benson '926** in an effort to remedy the acknowledged deficiencies of **Yon '824**. However, **Benson '926**, which discloses a use of browser cookies, fails to remedy the acknowledged deficiencies of **Yon '824**.

Benson '926 discloses a use of browser cookies. **Yon '824** discloses a method and system for selecting product colors. It requires a very big leap to start with the teachings of **Yon '824/Benson '926** and then end up with the features as set forth in claim 18.

Accordingly, in view of the above, Applicants respectfully submit that this rejection of claim 18 should be withdrawn.

CLAIM 19:

Yon '824 and **Benson '926**, alone or in combination, fail to describe, teach, or suggest the features set forth in claim 19, at lines 4-16, in combination with the other claimed features. The features set forth in claim 19, at lines 4-16, are shown herein.

specifying users of the color-designating server by accessing a customer database which stores user information, comprising user ID for specifying users of the color-designating server, and use information including requirements relating to items to be colored, predetermined in correlation with the user ID, and types of resin and dye or pigment which can be used for the requirements;

when the user has been identified, transmitting a conditions-designating screen for designating conditions data, required for determining matchable colors, to the user terminal,

the conditions-designating screen displays the requirements and the types of resin and dye or pigment, which are stored in the customer database in correlation with the identified user, so that the user can designate conditions data from the requirements and the types of resin and dye or pigment displayed on the conditions-designating screen; and

determining colors which can be matched under the conditions specified by the conditions data, designated in the conditions-designating screen, by consulting a matchable color database, and transmitting the result to the user terminal.

Furthermore, as discussed above, the Examiner did not apply the correct teaching-suggestion-motivation test for an obviousness rejection under 35 USC 103(a).

The Examiner has acknowledged that **Yon '824** is deficient. The Examiner has relied on **Benson '926** in an effort to remedy the acknowledged deficiencies of **Yon '824**. However, **Benson**

'926, which discloses a use of browser cookies, fails to remedy the acknowledged deficiencies of Yon '824.

Benson '926 discloses a use of browser cookies. **Yon '824** discloses a method and system for selecting product colors. It requires a very big leap to start with the teachings of **Yon '824/Benson '926** and then end up with the features as set forth in claim 19.

Accordingly, in view of the above, Applicants respectfully submit that this rejection of claim 19 should be withdrawn.

II. In the Office Action dated August 18, 2006, the Examiner has rejected claims 10, 13, and 14 under 35 USC 103(a) as obvious over Yon '824 in view of Benson '926 and USP 5,383,111 (Homma '111).

Applicants respectfully traverse this rejection, for the following reasons.

Homma '111 fails to remedy the above-described deficiencies of **Yon '824** and **Benson '926**.

Homma '111, **Yon '824**, and **Benson '926**, alone or in combination, fail to describe, teach, or suggest the features set forth in claim 1, at lines 10-21, in combination with the other claimed features.

Homma '111, Yon '824, and Benson '926, alone or in combination, fail to describe, teach, or suggest the features set forth in claim 12, at lines 19-30, in combination with the other claimed features.

Accordingly, in view of the above, Applicants respectfully submit that the rejection of claims 10, 13, and 14 should be withdrawn by virtue of their dependency.

In view of the aforementioned remarks, all claims currently pending are believed to be in condition for examination.

If, for any reason, it is felt that this application is not now in condition for allowance, the Examiner is requested to contact the Applicants' undersigned attorney at the telephone number indicated below to arrange for an interview to expedite the disposition of this case.

U.S. Patent Application Serial No. **10/026,823**

Amendment filed November 16, 2006

Reply to OA dated August 18, 2006

In the event that this paper is not timely filed, the Applicants respectfully petition for an appropriate extension of time. Please charge any fees for such an extension of time, and any other fees which may be due now or in the future with respect to this application, to Deposit Account No. 01-2340.

Respectfully submitted,
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